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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Samsung Electronics Co., Ltd.

Serial No. 78436161

Mincheol Kim of Knobbe, Martens, Olson & Bear for Samsung Electronics Co., Ltd.

Brian D. Brown, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Seeherman, Quinn and Walsh, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Samsung Electronics Co., Ltd. to register the mark WIDEPASS for "optical fibers."¹

The trademark examining attorney has refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, if applied to applicant's goods, so resembles the previously registered mark WIDELIGHT for "optical fibres; fiber optic cables; and

¹ Application Serial No. 78436161, filed June 16, 2004, based on an allegation of a bona fide intention to use the mark in commerce.

parts and accessories of the aforesaid goods sold as a unit therewith, namely, connectors, joints, couplers, splitters, splicers and switchers,"² as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs.

The examining attorney maintains that the goods are, in part, identical and that the marks are similar. In comparing the marks, the examining attorney places significant weight on the fact that "WIDE" appears at the beginning of each mark and that, therefore, this identical portion is most likely to be remembered by purchasers. As to the third-party evidence submitted by applicant, the examining attorney finds it unpersuasive, pointing out that only one of the registrations lists "optical fibers" in the identification of goods.

Applicant argues that the marks WIDEPASS and WIDELIGHT are different in sound, appearance, meaning and commercial impression. Contrary to the examining attorney's assertion, it cannot be said, applicant argues, that "WIDE" is the dominant portion in either mark. Applicant also points to the state of the trademark register, highlighting the registration of hundreds of "WIDE-" formative marks,

² Registration No. 2701674, issued April 1, 2003.

and the coexistence of several "sets" of third-party registered marks owned by different entities, each beginning with the term "WIDE" and covering identical, overlapping or similar goods, some even in International Class 9. In connection with this argument, applicant submitted a summary from the USPTO's TESS database that simply listed the registrations by number and mark; applicant also submitted copies of certain of the registrations.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also: *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also: *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The goods, in part, are identical. "Applicant admits that the 'optical fibers' included in the present

application are identical to the 'optical fibres' in the cited registration." (Request for Reconsideration, pp. 2-3). See *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) [likelihood of confusion must be found if there is likelihood of confusion involving any item that comes within the identification of goods in the involved application]. Although we have focused our attention on the identity between applicant's and registrant's optical fibers, we also find that applicant's optical fibers are closely related to the other fiber optic goods covered by the cited registration. Applicant's and registrant's goods are presumed to move in the same trade channels to the same classes of purchasers. The identity, in part, between the goods is a factor that weighs heavily in favor of affirmance of the refusal.

With respect to the marks, we note at the outset that where the goods are identical, "the degree of similarity [between the marks] necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1992).

Thus, we turn to a comparison of the marks WIDEPASS and WIDELIGHT, together with, as applicant also asserts,

the additional du Pont factor of the number and nature of third-party marks.

As to appearance and sound, the marks WIDEPASS and WIDELIGHT have the obvious similarity, in both appearance and pronunciation, of beginning with the same word, "WIDE." See Presto Products v. Nice-Pak Products, Inc., 9 USPQ2d 1895, 1897 (TTAB 1988) [it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered]. The second half of the marks, however, are different in both sound and appearance.

As to meaning, as already noted, each mark begins with "WIDE" followed by the word "PASS" or "LIGHT." Applicant posits that the cited mark WIDELIGHT "suggests a big or broad light," and "does not bring to mind any meaning or impressions related to the passage of a matter." (Brief, p. 5). Contrary to applicant's contention, however, we find that registrant's mark suggests the passage of light through registrant's optical fibers, and that the optical fibers provide a passage for a broad flow of light. According to applicant, its mark WIDEPASS "suggests the passage or flow of a certain thing, where such passage or flow is broad and wide." (Brief, p. 5). We agree; however, given that applicant's mark is intended for optical fibers, the "certain thing" to be passed is light.

Thus, applicant's mark suggests that its optical fibers allow a wide or large amount of light to pass through. Accordingly, both marks have similar meanings, that is, both suggest that the optical fibers allow a wide or large amount of light to pass through. See Kenner Parker Toys Inc. v. Rose Art Industries Inc., 963 F.2d 350, 22 USPQ2d 1453, 1457 (Fed. Cir. 1992) [PLAY and FUN, in overall context of competing marks, convey a very similar impression; in the context of the specific goods, the concepts of fun and play tend to merge].

As explained above, although there are specific differences between the marks, there are also similarities between them in that both start with the word "WIDE" and have the same number of syllables (two). And, significantly, both marks, when considered in the context of the goods to which they are applied, suggest the same general idea. In sum, the marks convey similar overall commercial impressions.

Applicant's principal argument that the cited mark is weak centers on the coexistence on the register of "WIDE-" formative marks. Applicant submitted a printout of a TESS search report listing over 900 third-party registrations of marks containing the term "WIDE." More specifically, applicant introduced photocopies of over 140 of these

registrations that cover goods classified in International Class 9. Applicant has highlighted certain third-party pairs of marks beginning with the word "WIDE" that have been registered for goods listed in International Class 9. Applicant essentially argues that if these respective "sets" of "WIDE-" formative marks (each "set" covering goods that are, according to applicant, related and in the same field) can coexist on the register, then applicant's and registrant's marks likewise can coexist without likelihood of confusion.

The third-party registration evidence does not persuade us that confusion is not likely. Firstly, the registrations are not evidence of use of the marks shown therein. Thus, they are not proof that consumers are familiar with such marks so as to be accustomed to the existence of similar marks in the marketplace, and as a result are able to distinguish between the "WIDE" marks based on slight differences between them. *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); and *Richardson-Vicks, Inc. v. Franklin Mint Corp.*, 216 USPQ 989 (TTAB 1982). Secondly, and more significantly, all but one of the "sets" of registrations are for a variety of goods in International Class 9 not involving fiber optics; thus, they are of little probative

value. See *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1740 (TTAB 1991), *aff'd unpub.*, (Appeal No. 92-1086, Fed. Cir., June 5, 1992). Only one "set" lists goods relating to fiber optics; and, one of the registrations of the "set" is the cited registration (the other being a registration for the mark WIDEVAM covering "telecommunications equipment, namely, chassis that fit within fiber distribution frames to hold optical components, namely, splitters, multiplexers, attenuators, optical switches and patch cords"). Indeed, as pointed out by the examining attorney, the record before us shows that the only "WIDE-" formative mark registered for "optical fibers" is registrant's mark. Moreover, because the goods in the various third-party registrations are different from "optical fibers," we cannot conclude that the term "WIDE" has a particular significance for such products, such that other elements of a mark should be accorded greater weight when we compare the marks in their entireties.

Although applicant is silent as to the sophistication of purchasers, it is reasonable to assume that prospective purchasers of fiber optic products will be knowledgeable in the field. Even assuming, however, that purchases are carefully made, we find that the similarity between the marks and the identity of the goods outweigh any

sophisticated purchasing decision. See HRL Associates, Inc. v. Weiss Associates, Inc., 12 USPQ2d 1819 (TTAB 1989), *aff'd*, Weiss Associates, Inc. v. HRL Associates, Inc., 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) [similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods]. The fact that purchasers may be sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated in the field of trademarks or immune from source confusion. See In re Research Trading Corp., 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), citing Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd., 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ["Human memories even of discriminating purchasers...are not infallible."]. See also In re Decombe, 9 USPQ2d 1812 (TTAB 1988).

We conclude that purchasers familiar with registrant's optical fibers sold under the mark WIDELIGHT would be likely to believe, upon encountering applicant's mark WIDEPASS for optical fibers, that the goods originated with or are associated with or sponsored by the same entity.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d

Ser No. 78436161

840, 6 USPQ2d 1025 (Fed. Cir. 1988); and In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register is affirmed.